

Remarks

Claims 1 and 3-13 are pending. Claim 12 has been amended to correct typographical errors with respect to punctuation. Importantly, the claim amendments should not be construed to be an acquiescence to any of the claim rejections. Rather, these actions are being made solely to expedite the prosecution of the above-identified application. The Applicants expressly reserve the right to prosecute further the same or similar claims in subsequent patent applications claiming the benefit of priority to the instant application (35 USC § 120).

Claim Rejections under 35 USC § 103(a)

US 2006/0140984 in view of US 5,143,717

The Examiner contends that claims 1 and 3-13 are obvious over US 2006/0140984 in view of 5,143,717. The Applicants respectfully traverse.

The actual filing date (i.e., the international filing date of the parent PCT application) of the instant application is October 4, 2004. Moreover, the instant application, and the underlying PCT application, properly claimed priority to: USSN 60/508,495, filed October 3, 2003; and USSN 60/560,890, filed April 4, 2004. Finally, January 20, 2006 is the so-called “§ 102(e) date” for the instant application.

US 2006/0140984 published on June 29, 2006. Importantly, this date is: after the filing dates of the two provisional applications to which the instant application claims priority; and after the international filing date of the PCT application on which the instant application is based. Therefore, based solely on its publication date US 2006/0140984 does not qualify as prior art against the instant application.

US 2006/0140984 claims priority to three earlier filed applications: PCT application IB03/05527, filed October 24, 2003; USSN 60/429,546, filed November 29, 2002; and Israel application serial number 152486, filed October 25, 2002. PCT application IB03/05527, filed October 24, 2003, was published as WO 2004/037225 on May 6, 2004. Importantly, the publication date of WO 2004/037225 is after the priority dates to which the instant application is entitled: USSN 60/508,495, filed October 3, 2003; and USSN 60/560,890, filed April 4, 2004.

Therefore, based solely on its publication date WO 2004/037225 does not qualify as prior art against the instant application.

As noted above, US 2006/0140984 is based on PCT application IB03/05527, filed October 24, 2003, published as WO 2004/037225. This PCT application claims priority to two earlier-filed applications: USSN 60/429,546, filed November 29, 2002; and Israel application serial number 152486, filed October 25, 2002. However, the disclosures of the two priority applications differ from the disclosure of WO 2004/037225. Most importantly, a discussion of hydrofluoroalkanes as possible propellants in the systems described in this family of applications *does not appear in either priority document*. Indeed, this class of propellants is first mentioned in WO 2004/037225, filed October 24, 2003. Critically, the effective filing date (October 24, 2003) of the disclosure regarding hydrofluoroalkane propellants is AFTER the filing date of the earliest-filed provisional application to which the instant application properly claims priority (October 3, 2003). Therefore, US 2006/0140984 does not qualify as prior art under 35 USC § 102(e) teaching “hydrofluoroalkane propellants” against any of the rejected claims.

Further, US 5,143,717, filed August 2, 1989, and issued September 1, 1992, does not teach hydrofluoroalkane propellants. In other words, combining the teachings of US 2006/0140984 and US 5,143,717 does not resolve the shortcomings of US 2006/0140984 vis-à-vis the requirement for a hydrofluoroalkane propellant in the rejected claims.

Consequently, the Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness with respect to the rejected claims. According to MPEP § 2143, in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine teachings of the references. Second, there must be a reasonable expectation of success. Finally, *the references, when combined must teach or suggest all of the claim limitations*. The Applicants submit that the Examiner has not presented a combination of prior art references that teach or suggest all of the claim limitations. Specifically, the Examiner has not presented a combination of references that qualify as prior art, which teach or suggest the use of hydrofluoroalkanes (HFAs) as a propellant in the claimed formulations.

US 2006/0233721 in view of US 6,075,056

The Examiner contends that claims 1 and 3-13 are obvious over US 2006/0233721 in view of 6,075,056. The Applicants respectfully traverse.

The actual filing date (i.e., the international filing date of the parent PCT application) of the instant application is October 4, 2004. Moreover, the instant application, and the underlying PCT application, properly claimed priority to: USSN 60/508,495, filed October 3, 2003; and USSN 60/560,890, filed April 4, 2004. Finally, January 20, 2006 is the so-called “§ 102(e) date” for the instant application.

US 2006/0233721 published on October 19, 2006. Importantly, this date is: after the filing dates of the two provisional applications to which the instant application claims priority; and after the international filing date of the PCT application on which the instant application is based. Therefore, based solely on its publication date US 2006/0233721 does not qualify as prior art against the instant application.

US 2006/0233721 claims priority to seven earlier filed applications: USSN 10/532,618, filed December 22, 2005; USSN 60/717,058, filed September 14, 2005; USSN 10/911,367, filed August 4, 2004; PCT application IB03/05527, filed October 24, 2003; USSN 60/492,385, filed August 4, 2003; USSN 60/429,546, filed November 29, 2002; and Israel application serial number 152486, filed October 25, 2002. USSN 10/532,618, filed December 22, 2005, was published on June 29, 2006. USSN 10/911,367, filed August 4, 2004, was published on March 31, 2005. PCT application IB03/05527, filed October 24, 2003, was published as WO 2004/037225 on May 6, 2004. Importantly, the publication dates of the three priority applications that were published (USSN 10/532,618; USSN 10/911,367; and WO 2004/037225) are all *after* the priority dates to which the instant application is entitled: USSN 60/508,495, filed October 3, 2003; and USSN 60/560,890, filed April 4, 2004. Therefore, based solely on their publication dates, none of these applications qualifies as prior art against the instant application.

US 2006/0233721 is a continuation-in-part of USSN 10/911,367, filed August 4, 2004; which application claims priority to USSN 60/492,385, filed August 4, 2003. Neither USSN

10/911,367, nor USSN 60/492,385, however, discloses the use of hydrofluoroalkanes as propellants in the systems described.

US 2006/0233721 is also based on USSN 60/717,058, filed September 14, 2005. The filing date of this provisional application is after the priority dates to which the instant application is entitled: USSN 60/508,495, filed October 3, 2003; and USSN 60/560,890, filed April 4, 2004.

US 2006/0233721 is a continuation-in-part of USSN 10/532,618, filed December 22, 2005. USSN 10/532,618 is, in turn, a § 371 national stage application based on PCT application IB03/05527, filed October 24, 2003, published as WO 2004/037225. This PCT application claims priority to two earlier filed applications: USSN 60/429,546, filed November 29, 2002; and Israel application serial number 152486, filed October 25, 2002. However, the disclosures of the two priority applications differ from the disclosure of WO 2004/037225.

Most importantly, a discussion of hydrofluoroalkanes as possible propellants in the systems described in this family of applications *does not appear in either priority document*. Indeed, this class of propellants is first mentioned in WO 2004/037225, filed October 24, 2003. Critically, the effective filing date (October 24, 2003) of the disclosure regarding hydrofluoroalkane propellants is AFTER the filing date of the earliest-filed provisional application to which the instant application properly claims priority (October 3, 2003).

Further, US 6,075,056, filed October 3, 1997, and issued June 13, 2000, does not teach hydrofluoroalkane propellants. In other words, combining the teachings of US 2006/0233721 and US 6,075,056 does not resolve the shortcomings of US 2006/0233721 vis-à-vis the requirement for a hydrofluoroalkane propellant in the rejected claims.

Consequently, the Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness with respect to the rejected claims. According to MPEP § 2143, in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine teachings of the references. Second, there must be a reasonable expectation of success. Finally, *the references, when combined must teach or suggest all of the claim limitations*. The Applicants submit that the Examiner has not presented a combination of prior art references that

teach or suggest all of the claim limitations. Specifically, the Examiner has not presented a combination of references that qualify as prior art, which teach or suggest the use of hydrofluoroalkanes (HFAs) as a propellant in the claimed formulations.

Accordingly, the Applicants respectfully request the withdrawal of the claim rejections based on 35 U.S.C. § 103(a).

Obviousness-Type Double Patenting Rejections

Claims 1 and 9-11 have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 5, and 17-19 of copending Application No. 11/128,947 (US 2005/0255048). In order to expedite prosecution to allowance of the pending claims, the Applicants submit herewith a Terminal Disclaimer, corresponding to the 11/128,947 application, that complies with the requirements of 37 CFR 1.321(c). The Disclaimer is accompanied by the required fee. 37 CFR 1.321(c).

Claims 1 and 9-13 have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 and 9-16 of copending Application No. 11/464,100 (US 2007/0036731). In order to expedite prosecution to allowance of the pending claims, the Applicants submit herewith a Terminal Disclaimer, corresponding to the 11/464,100 application, that complies with the requirements of 37 CFR 1.321(c). The Disclaimer is accompanied by the required fee. 37 CFR 1.321(c).

Claims 1 and 3-13 have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 and 9-16 of copending Application No. 11/552,457 (US 2007/0154402). In order to expedite prosecution to allowance of the pending claims, the Applicants submit herewith a Terminal Disclaimer, corresponding to the 11/552,457 application, that complies with the requirements of 37 CFR 1.321(c). The Disclaimer is accompanied by the required fee. 37 CFR 1.321(c).

Fees

The Applicants believe that they have provided for the required fees in connection with the filing of this paper. Nevertheless, the Director is hereby authorized to charge any required fee to our Deposit Account, **06-1448** reference **CPX-015.01**.

Conclusion

In view of the above remarks, the Applicants believe that the pending claims are in condition for allowance. If a telephone conversation with Applicant's Attorney would expedite prosecution of the application, the Examiner is urged to contact the undersigned.

Respectfully submitted,

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